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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/268,412	03/15/1999	ALBERT J. SILVERA	31045-7	8401

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07/28/2003

MITCHELL SILBERBERG & KNUPP  
11377 WEST OLYMPIC BOULEVARD  
LOS ANGELES, CA 90064

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

26

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 26

Application Number: 09/268,412  
Filing Date: March 15, 1999  
Appellant(s): SILVERA, ALBERT J.

**MAILED**  
**JUL 28 2003**  
**GROUP 3700**

\_\_\_\_\_  
Joseph G. Swan  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 13, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that each of the nine groups of claims do stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

Creative Crystal, Document 1997 , Web site: <http://www.creative-crystal.com/tattoos.html>

SkinWear Temporary Tattoos (admitted prior art in the instant specification, paragraph bridging pages 6-7, as a commercially available artificial tattoo, SkinWear)

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-9, 11, 15-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being obvious over "Creative Crystal" in view of "Skin Wear" tattoo and vice versa (herein after: Creative Crystal and Skin Wear). Creative Crystal teaches and suggests the application of artificial tattoos to the surface of shoes for decorating shoes. Creative Crystal is indefinite as to the type of artificial tattoos being used, and appears to be different from appellant's disclosed tattoo. However, the type of artificial tattoo used by appellant is admitted prior art as disclosed in appellant's specification, paragraph bridging Pages 6-7, as a commercially available artificial tattoo, Skin Wear. In view of such commercially known artificial tattoo and the Creative Crystal's teachings, **taken as**

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**a whole**, it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to have substituted one type of artificial tattoo with another type of artificial tattoo to be used in Creative Crystal **taken as a whole**, as an obvious alternative artificial tattoo for decorating shoes.

Alternatively, with respect to Skin Wear tattoo in view of Creative Crystal, it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to apply the Skin Wear tattoo to shoes as taught and suggested by Creative Crystal as an obvious alternative or added use for the Skin Wear tattoo.

As to applying the artificial tattoo to a smooth surface of the shoe, Creative Crystal is silent in this regard. However, the level of skill of attaching an artificial tattoo to a smooth surface or any surface that would accept such a tattoo is of such a low level that it would have been well within the skill of the ordinary skilled worker and would have been obvious at the time of appellant's invention.

With respect to the method claims, they are rendered obvious or inherent in the application of the commercially available Skin Wear tattoo in the combination proposed by examiner, since the **same** artificial tattoo is being used by appellant, which requires wetting the tattoo and then applying the tattoo to the shoe surface (Claims 1 and 8).

As to method claim 5, removing a first applied tattoo and applying a second tattoo to the shoe, such would have been obvious and well within the skill of the ordinary skilled worker, if a first tattoo is desired to be replaced for whatever reasons, e.g. a change of heart, first tattoo damaged or worn out, etc.

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As to the shoe surface being PVC, plastic, white, clear, or the smooth portion being stitched onto the shoe (claims 4, 6, 7, 15, 18, 21 and 22), these are common and well known shoes features. It would have been obvious to use shoes having any of such features in the combination as an obvious alternative or matter of design choice. Similarly, to have the smooth portion match the size of the tattoo (claim 17) would also be an obvious matter of design choice well within the skill of the ordinary skilled worker if so desired.

In response to appellant's request, Nadel et al. (5,577,828) and Drew (4,120,101) references are cited as examples that it is old and conventional to make shoes from transparent, clear PVC or plastic. Nadel `828 discloses a decorative panel (14) on footwear that is fabricated from either PVC and/or soft thermosetting or thermoplastic plastic material. Drew `101 discloses footwear where the plastic material of the upper is preferably a vinyl polymer, e.g. polyvinyl chloride (PVC).

3. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being obvious over Creative Crystal and Skin Wear as applied to claim 11 above, and further in view of Wasserman ('362). Creative Crystal and Skin Wear, as combined, teach the invention, except for locating the tattoo in a recessed portion of the shoe. Wasserman ('326) teaches and suggests locating and attaching a design element in a recess of a shoe (Figs. 1, 2 and 4). It would have been obvious to one of ordinary skill in the art at the time of appellant's invention to also apply the artificial tattoo of the combination in a recess of a shoe as taught and suggested by Wasserman ('326) as an obvious alternative location on a shoe for receiving a design. As to the dimensions of the recess

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(claims 13 and 14), they are deemed as obvious matters of design choices well within the skill of the ordinary skilled worker if so desired. Moreover, the dimensions have not been disclosed as being critical or serve any particular purposes.

**(11) Response to Argument**

Appellant's arguments filed in his brief of May 13, 2003 have been fully considered but they are not persuasive. In response to appellant's argument denying the undeniable i.e. that shoes are not smooth, white/clear or made of PVC or plastic, Nadel et al. (5,577,828) and Drew (4,120,101) references are cited as examples that it is old and conventional to make shoes from transparent, clear PVC. Nadel '828 discloses a decorative panel (14) on footwear that is fabricated from either PVC and/or soft thermosetting or thermoplastic plastic material. Drew '101 discloses footwear where the plastic material of the upper is preferably a vinyl polymer, e.g. polyvinyl chloride (PVC).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, "Creative Crystal" teaches and clearly suggests placing one or more artificial tattoos on footwear (irrespective of the type of artificial tattoo being used), it would have been obvious to

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one of ordinary skill in the art at the time of appellant's invention to have substituted one known type of artificial tattoo with another known type of artificial tattoo to be used for decorating shoes, as suggested by Creative Crystal. The use of Skin Wear type artificial tattoo is an obvious alternative, readily available to the ordinary skilled worker.

In response to appellant's argument and the inventor's declaration that stick-on tattoos adhere better to smooth plastic or smooth PVC surfaces, the level of skill of attaching an artificial tattoo to a smooth surface or any surface that would accept such a tattoo is of such a low level (examiner believes a six grader would have skill to find the proper surface by simple trial and error) that it would have been well within the skill of the ordinary skilled worker and would have been obvious at the time of appellant's invention. Furthermore, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

As explained above, the two references, Creative Crystal and Skin Wear, taken **as a whole** and in further view of Wasserman, clearly demonstrated a *prima facie* obviousness of appellant's claimed invention under 35 U.S.C. 103(a), and, therefore, is unpatentable.

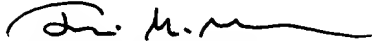
For the above reasons, it is believed that the rejections should be sustained.



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J. MOHANDESI  
PATENT EXAMINER

Respectfully submitted,

  
Jila M Mohandesi  
Examiner  
Art Unit 3728


JMM

July 25, 2003

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